

BR/GT I/134 e/71

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INTER-GOVERNMENTAL CONFERENCE
FOR THE SETTING UP OF A EUROPEAN
SYSTEM FOR THE GRANT OF PATENTS

Brussels, 3 November 1971
BR/GT I/134/71

- Secretariat -

W o r k i n g D o c u m e n t

for the 10th meeting of Working Party I
to be held from 22 to 26 November 1971

Article: 130

Problem: Advance payment of renewal fees in the event
of increases in fees

Drawn up by: German delegation

The delegations to Working Party I will find attached
a note from the German delegation on the question of whether,
and on what terms, renewal fees may be paid in advance in
accordance with Article 130.

BR/GT I/134 e/71 rin/AV/prk

NOTE FROM THE GERMAN DELEGATION

on the question of whether, and on what terms, renewal fees may be paid in advance in accordance with Article 130

At its 6th meeting, held from 8 to 18 June 1971 in Brussels, the EEC "Community Patent" Working Party adopted for the Second Convention an Article 53 on the payment of renewal fees, which was based on Article 130 of the First Convention. During discussion of Article 53, the question arose as to whether the payment of a fee releases a proprietor from further obligation even in cases where an increase in the rate of a renewal fee comes into force on or shortly before the due date but the fee has been paid at the previous rate before such date. The Working Party was also of the opinion that this question required clarification and that, moreover, a provision affording the proprietor a certain degree of protection should be considered.

In view of the fact that the same questions arose in connection with Article 130 of the First Convention, the EEC "Community Patent" Working Party did not draw up corresponding provisions for the time being and asked the German delegation to submit the problem to Working Party I together with a proposed solution that could be transposed into the Second Convention. This proposal is submitted to Working Party I in this note.

When it examined the problem, the German delegation came to the conclusion that, subject to provisions affording a certain degree of protection, the basic principle should be that any renewal fee is to be paid at the rate in force on the day on which it falls due. An advance payment at the lower rate should not release the applicant from the obligation to pay a further amount if a higher rate has come into force between the time of making the advance payment and that at which it

was due. For this reason the German delegation first proposes that a second sentence making this clear be added to Article 130, paragraph 2.

However, in view of this principle, which would be stated in paragraph 1, it would seem necessary to draw up a provision affording some protection to applicants who have punctually paid renewal fees shortly before or even shortly after the entry into force of the increase in the rate of renewal fees, but still at the earlier rate.

The "Community Patent" Working Party first considered laying down that patentees should be informed in good time of any imminent increase in renewal fees. It was of the opinion that provisions should be laid down that any measures taken by the Administrative Council, should be published in good time in the Official Journal of the European Patent Office, and that in the case of amendments to the Rules relating to Fees such publication should be at least three months prior to their entry into force. The German delegation came to the conclusion that there was no need to make an explicit provision of this nature in the Convention, as it should be self-evident that all decisions of the Administrative Council should be published sufficiently early for all concerned to make the necessary adjustments.

Therefore, although as a general rule early publication in the Official Journal of the increase in fees should enable the applicant to adjust his payments to the increase, it might nevertheless be expedient to lay down a special protective provision so that applicants paying fees punctually either directly before or directly after the increase in fees should not be put at a disadvantage. It is proposed that paragraph 2a should contain such a protective provision. The reasoning of paragraph 2a is based on that of paragraph 2. It makes it possible to make subsequent payment of the difference between the old and the new rates for the fees without paying an additional fee. As paragraph 2a only requires that the fee

according to the old rate be paid "punctually", it also covers the event of advance payment.

The question now arises as to whether an applicant who has made a punctual payment in accordance with the old rate is to be requested to make the necessary subsequent payment by the European Patent Office. It was however considered unnecessary to provide for such a request in paragraph 2a, as no request is provided for in paragraph 2. When drafting paragraph 2, Working Party I did not want to oblige the European Patent Office to issue requests, although this does not exclude the possibility of its doing so on its own initiative. This could in particular be considered if requests could be drawn up without difficulty by a computer. The same considerations also apply to the proposed paragraph 2a. Given the necessary technical equipment, the European Patent Office could therefore issue requests to make good the deficit.

It should be pointed out in conclusion that the same questions also arise in connection with increases in fees other than renewal fees. The German delegation's proposal is however restricted to renewal fees as covered by Article 130, and does not make corresponding proposals for the Rules relating to Fees in respect of other fees. This should not be necessary, since the Administrative Council may, when raising other fees and amending the Rules relating to Fees accordingly, adopt corresponding transitional measures, taking into account the nature of the fees being raised.

BR/GT I/134 e/71 (Annex):ley/KM/prk

Article 130

Payment of renewal fees

(1) Renewal fees in respect of the coming year shall be due on the last day of the month containing the anniversary of the date of filing of the European patent application.

(2) When a renewal fee has not been paid before the due date indicated in paragraph 1, the fee may be validly paid within six months of the said date, provided that the additional fee prescribed by the Rules relating to Fees adopted pursuant to this Convention is paid at the same time.

(3) If a renewal fee has not been paid by the end of the time limit referred to in paragraph 2, the European patent application shall be deemed to be withdrawn.

Article 130

Payment of renewal fees

(1) Renewal fees in respect of the coming year shall be due on the last day of the month containing the anniversary of the date of filing of the European patent application. Renewal fees shall be paid in accordance with the rate in force on the day on which they fall due.

(2) +

(2a) Any renewal fee falling due within three months of the entry into force of an increase in fees and paid punctually but only to the amount valid before the increase shall be deemed to have been validly paid, subject to the deficit being made good within six months of the date on which the fee fell due. Payment of the additional fee referred to in paragraph 2 shall not be required.

(3) If a renewal fee has not been paid punctually with the additional fee referred to in paragraph 2, or, in the case referred to in paragraph 2a, with the deficit, the European patent application shall be deemed to be withdrawn.

Note to paragraph 1:

The German text only contains an amendment to the first sentence.

